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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/510,561

10/07/2004

Masanori Ogawa

2710-73145

9039

7590
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1185 Avenue of the Americas
New York, NY 10036

11/29/2007

EXAMINER

WATKINS III, WILLIAM P

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

11/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/510,561

Applicant(s)

OGAWA ET AL.

Examiner

William P. Watkins III

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1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4 September 2007 has been entered.

2. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 is indefinite as it depends from cancelled claim number 9.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the

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differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 2-4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kano et al. (U.S. 4,871,585) in view of Dungan (U.S. 2,328,203).

As a matter of claim construction, the part that is masked in instant claim 2 is taken as being a positive limitation of the claim. The claim is taken as being to a combination of a mask and a part that is masked.

Kano et al. teaches a part with a through hole where the inside of the through hole is masked from penetration by liquid from both sides of the through hole by expansion of a rubber plug inserted into the hole so that both ends are bigger than the circumference of the hole (abstract, Figure 1). Dungan teaches a flexible rubber mask where both ends are larger than the portion of the hole to which it is inserted in order to seal both ends of the hole circumference (elements 28 and 21). The instant invention claims a part with a through hole with a plug mask where there is a flange on each end that is larger than the through hole and where the flanges seal the wall of both ends of the through hole. It would have been obvious to one of ordinary

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skill in the art to have used a mask such as taught by Duggan in the through hole of Kano et al. in order to avoid a swelling step when sealing the wall of the through hole from both sides because of the teaching of enlargements at both ends of a flexible rubber mask by Duggan. No particular weight is given to the method of forming the mask unless it can be shown to cause different final product qualities.

5. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kano et al. in view of Duggan as applied to claims 2-4 and 10 above, and further in view of Horiki et al. (U.S. 5,902,642).

Horiki et al. teaches multiple insertion members on a single sheet in order to seal multiple holes (Figure 6). The instant invention claims multiple insertion parts on a continuous top flange. It would have been obvious to form multiple insertion members of the combination of Kano et al. in view of Duggan on a single upper flange in order to allow sealing of multiple holes because of the teachings of Horiki et al.

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6. Applicant's arguments filed 4 September 2007 with respect to claims 2-6 and 10 have been considered but are not found to be persuasive.

Applicant continues to argue that there is no flange which covers and seals the outside circumference of the hole part into which the mask is inserted. The examiner maintains his position, advanced in the advisory action mailed 24 August 2007, that the use of the flange of Dungan that seals around an internal hole end, teaches the general concept of sealing a bore hole with a flange and that one of ordinary skill in the art could easily modify the concept to apply it to Kano et al., where the flange is beyond the hole. Element 28 of Dungan can be said to form a hollow portion since the inside of the wall of the flange is pushed outward beyond the circumference of the main portion of the plug wall, and thus can be said to have a hollow portion in relation to the inside main plug wall. Applicant's new limitations thus do not distinguish over the combination of the cited references.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 571-272-1503. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one

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business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



WILLIAM P. WATKINS II.
PRIMARY EXAMINER

WW/ww

November 26, 2007